



402-038-19

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2833

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: David G. McCarthy : Examiner: B. Hammond
: :
Title: Retractable Receptacle For : Group Art Unit: 2833
Furniture A Vehicle Door : :
Serial No. 08/951,276 : :
Filed: October 16, 1997 : :

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Box AF

REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION

Applicant respectfully requests reconsideration of the final rejection of all pending Claims 1 - 20 made by the Examiner in the Official Action dated November 18, 2004.

Independent Claims 1, 16 and 19 are pending in this patent application.

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Mark P. Stone
MARK P. STONE
Reg. No. 27,954

11/24/04
(Date of Deposit)

At page 2 of the Official Action, independent Claims 1 and 16 have been rejected under 35 U.S.C. Section 103(a) as being obvious over a combination of the Byrne patent (U.S. Patent No. 4,747,788) in view of the Mitchell et al patent (U.S. Patent No. 4,511,198). At page 3 of the Official Action, independent Claims 1 and 19 have been rejected under 35 U.S.C. Section 103(a) as being obvious over Mitchell et al. Therefore, independent Claim 1 has been rejected as being obvious over Byrne in view of Mitchell et al, and has also been rejected as being obvious over the Mitchell et al patent alone; independent Claim 16 has been rejected as being obvious over a combination of the Byrne patent in view of the Mitchell et al patent; and independent Claim 19 has been rejected as being obvious over the Mitchell et al patent alone.

Before discussing the prior art rejections, Applicant notes that each of the pending independent claims defines a device in which a top surface of a receptacle is planar with the top surface of an article of furniture in which the receptacle is mounted when the receptacle is in its retracted position. For the reasons to be discussed below, Applicant respectfully submits that none of the prior art applied in the Official Action teaches or suggests the devices defined by independent Claims 1, 16 and 19 when all positively recited features of these claims are considered in the patentability determination, and when the

teachings of the prior art references are considered in their entireties, including teachings diverse to Applicant's pending claims.

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With regard to the rejection of independent Claim 1 over a combination of the Byrne and Mitchell patents, the top of the Byrne housing is above the top surface of a work surface in which the housing is mounted when the housing is in a retracted position. See, for example, Fig. 1 of the patent which discloses that a collar 116 mounted to the top of the housing 108 is above both a working surface 104 and the veneer 106 of the working surface, when the housing 108 is in its retracted position. This arrangement of structure in the Byrne patent is done intentionally. As disclosed at Column 7, Lines 8 - 13, this structural arrangement enables the collar 116 to provide a supporting surface for the housing 108. The patent expressly discloses that "...the outer perimeter of the collar 116 overhangs the slot 102 [the opening in the work surface] so as to be positioned above the work surface 104 with the lower surface of the collar 116 substantially flush with the veneer 106. In this manner, the collar 116 provides a supporting surface for the housing 108." Since the lower surface of the collar 116 is substantially flush with the veneer 106, the upper surface of the

collar 116 is clearly elevated above the upper surface of the work surface 104 and the veneer 106.

Modification of the Byrne patent, such that the top surface of the collar 116 is flush with the working surface 104 so that the top surface of the collar 116 is planar with the top of the working surface, would defeat the intended purpose and express objective of the arrangement of structure disclosed by Byrne, namely to enable the bottom surface of the collar 116 to provide a supporting surface for the housing 108 by permitting the outer perimeter of the collar 116 to overhang the slot 102. Clearly, modification of the Byrne patent which would defeat an intended purpose and express objective of that patent is not suggested by the prior art. See, for example, Micro-Chemical, Inc. v. Great Plains Chemical Co., Inc., 41 USPQ 2d 1238 (Fed. Cir. 1997).

The Mitchell patent likewise does not teach or suggest an arrangement by which the top of a housing is planar with the top surface of a working surface when the housing is in a retracted position. On the contrary, the Mitchell patent discloses that the top surface of the housing 50 is recessed below the top of a working surface 12 when the housing is in its retracted position (See Fig. 2 of the drawing). It is therefore necessary to provide a removable closure element (a disk) to be placed over the

opening 12 in the work surface to provide an uninterrupted work surface (See Column 3, lines 61 - 68 of the Mitchell specification). Thus, the Mitchell patent provides an uninterrupted top surface by using structure and a structural arrangement (a separate closure disk removably mounted on a recessed annular shoulder 16 in the circular opening 14) which is distinctly different from the structure and structural arrangement disclosed by Applicant and recited in independent Claim 1.

Since neither the Byrne or Mitchell patents teach or suggest the feature of independent Claim 1 in which the top of the housing is planar with the top of the work surface when the housing is in a retracted position, a combination of these references as proposed in the Official Action is clearly not suggested or motivated by the prior art itself. On the contrary, as a result of the diverse teachings of the two references, the only suggestion for modifying/combining the references as proposed in the Official Action must be derived from using Applicant's own disclosure as a guide for the modification/combination. However, a rejection based upon use of Applicant's own disclosure as a guide for combining references is improper as a matter of law. See, for example, In re Fritch, 23 USPQ 2d 1780 (Fed. Cir. 1992); Orthopedic Equipment Co. v. United States, 217 USPQ 193 (Fed. Cir. 1983).

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With regard to the rejection of independent Claim 1 as being obvious over the Mitchell patent alone, as discussed above, the top surface of the housing 50 of the Mitchell patent, when in its retracted position, is recessed below a working surface 12 (See Fig. 2 of the drawing), and it is necessary to place a removable cover element over the opening 14 to provide an uninterrupted working surface 12 (See Column 3, lines 61 - 68 of the Mitchell specification). Applicant's independent Claim 1 recites structure and structural arrangement by which the top surface of the housing itself, when in its retracted position, is planar with the top surface of the article of furniture in which the housing is mounted, to provide an uninterrupted top working surface. Thus, the article of furniture defined by independent Claim 1 provides a planar top working surface using structure and structural arrangement which is completely different from that disclosed by the Mitchell patent. Applicant's claimed article of furniture eliminates the need to provide a separate structural elements (a removable cover, an annular shoulder to support the removable cover), for providing an uninterrupted top working surface when the housing is in its retracted position.

There is no suggestion or motivation in the prior art itself to modify the Mitchell patent in any manner rendering independent

Claim 1 obvious. Modification of the Mitchell patent to result in the article of furniture recited in independent Claim 1 is not simply making plural parts unitary, since the housing 50 and the removable cover serve different functions. Moreover, the Mitchell patent includes a recessed annular shoulder 16 around the opening 14 solely for the purpose of supporting the removable closure element (See Column 3, lines 61 - 68 of the Mitchell specification). Therefore, modification of the Mitchell patent to result in the article of furniture recited in independent Claim 1, would require 1). providing a housing arranged so that the top surface thereof is planar with a working surface when the housing is in its retracted position, 2). elimination of the removable closure element, and 3). further structural modification to eliminate the annular shoulder 16 provided exclusively for the purpose of supporting the removable closure element. Clearly, there is no suggestion or motivation in the prior art itself to modify the structure and structural arrangement of the Mitchell patent in any manner rendering independent Claim 1 obvious. On the contrary, the only suggestion for such modifications must be derived from Applicant's own disclosure, and it is improper to reject independent Claim 1 based upon modifications to the prior art which are taught only by Applicant's disclosure. See, for example, Micro-Chemical, Inc. v. Great Plains Chemical Co., Inc., supra; In re Fritch, supra; and Orthopedic Equipment Co., supra.

Therefore, although both Applicant's independent Claim 1 and the Mitchell patent provide an uninterrupted working surface when a housing is fully retracted within an opening in the working surface, the structure and structural arrangement disclosed in the Mitchell patent for attaining this objective is distinctly different from the structure and structural arrangement disclosed by Applicant and recited in independent Claim 1.

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With regard to the rejection of independent Claim 16 as being obvious over a combination of the Byrne and Mitchell patents, independent Claim 16 expressly recites that the top surface of the receptacle is planar with the top surface of the article of furniture in which the receptacle is mounted when the receptacle is in its retracted position. Therefore, independent Claim 16 is allowable over a combination of the Byrne and Mitchell patents for the same reasons discussed above with respect to the rejection of independent Claim 1 as being obvious over a combination of the Byrne and Mitchell patents.

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With regard to the rejection of independent Claim 19 as being obvious over the Mitchell patent, independent Claim 19

recites that the top surface of the receptacle is planar with the top surface of an article of furniture in which the receptacle is mounted when the receptacle is in its retracted position. Therefore, independent Claim 19 is allowable over the Mitchell patent for the same reasons discussed above with respect to the rejection of independent Claim 1 as being obvious over the Mitchell patent.

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For the reasons discussed herein, Applicant respectfully submits that neither the Byrne patent, the Mitchell patent, or a combination of the Byrne and Mitchell patents, teaches or suggests the devices defined by independent Claims 1, 16, and 19 when all positively recited features of these claims are considered in the patentability determination. There is clearly no suggestion or motivation in the prior art itself to modify/combine these two references in any manner rendering Applicant's independent claims obvious. As a result of the diverse teachings of the applied prior art references, the only basis for modifying/combining these references must be derived from the use of Applicant's own disclosure as a guide. However, it is well established that it is improper, as a matter of law, to use Applicant's own disclosure as a guide for selectively modifying and/or combining different features of prior art

references to reconstruct Applicant's claims. Micro-Chemical, Inc. v. Great Plains Chemical Co., Inc., supra; In re Fritch, supra; and Orthopedic Equipment Co., supra.

Applicant submits that independent Claims 1, 16, and 19 are in condition for allowance. The remaining dependent claims, each of which depend directly or indirectly from one of the independent claims, are allowable, at least for the same reasons as their respective parent independent claims.

Applicant gratefully acknowledges the Examiner's indication at page 2 of the Official Action that the prior objection to the drawings has been withdrawn.

Applicant respectfully submits that this patent application is in condition for allowance, and favorable action is respectfully requested.

Respectfully submitted,



Mark P. Stone
Reg. No. 27,954
Attorney for Applicant
25 Third Street, 4th Floor
Stamford, CT 06905
(203) 329-3355